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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application No. : 09/821,195
Applicants : Timothy C. Loose
Wayne H. Rothschild
Norman R. Wurz
Filed : March 29, 2001
Title : Gaming Machine With An Overhanging Touch Screen
TC/A.U. : 3714
Examiner : Carmen D. White
Docket No. : 47079-00086
Customer No. : 30223

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to the Commissioner for Patents, Mail Stop Appeal Brief - Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on June 15, 2004.

Signature: Janet L. Newmaker
Janet L. Newmaker

APPEAL BRIEF PURSUANT TO 37 C.F.R. §§ 1.191 AND 1.192

Dear Sir:

This Appeal Brief is filed pursuant to the Applicants' appeal to the Board of Patent Appeals and Interferences ("Board") from the final rejection of claims 1-8 in an Office Action dated December 16, 2003. A Notice of Appeal was filed April 16, 2004. The due date for this Appeal Brief is two months from the receipt date by the USPTO of the Notice of Appeal, i.e., June 19, 2004, and this paper is being filed before this due date.

In accordance with 37 C.F.R. § 1.192(a), this brief is being submitted in triplicate.

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I. REAL PARTY IN INTEREST

The real party in interest is WMS Gaming Inc., having a place of business at 800 South Northpoint Boulevard, Waukegan, IL 60085.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences that will directly affect, be directly affected by, or have a bearing on the Board of Patent Appeals and Interferences in the present appeal.

III. STATUS OF CLAIMS

Claims 1-8 are currently pending in the above-referenced application. No claims have been allowed.

The Applicants appeal from the final rejection of claims 1-8. Claims 1-8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,342,047 to Heidel et al. ("Heidel") in view of European Patent No. EP 0 789 338 to Bruzzese ("Bruzzese"). The appealed claims are attached as Appendix A. Heidel and Bruzzese are attached as Appendices B and C, respectively. A copy of the Office Action mailed December 16, 2003, that finally rejected the claims is attached as Appendix D.

IV. STATUS OF AMENDMENTS

The Applicant filed a Reply After Final, mailed on March 18, 2004, in response to the final Office Action mailed December 16, 2003. A copy of the Reply After Final is attached as Appendix E. In an Advisory Action mailed April 13, 2004, the Examiner indicated that this amendment would be entered. A copy of the Advisory Action is attached as Appendix F.

V. SUMMARY OF INVENTION

The present invention is directed to a gaming machine with an overhanging touch screen. Specification, page 2, lines 5-6.

According to one embodiment of the invention, the gaming machine is controlled by a processor that acts in response to a wager. Specification, page 3, lines 7-8. The gaming machine includes a display and a unitary touch screen. *Id.* at 7-9. The display includes both a video portion and a non-video portion, both of which are overlapped by the unitary touch screen. *Id.* at 9-10. The video portion includes player-selectable first indicia that is selectable via the unitary touch screen. *Id.* at 10-11. The non-video portion includes permanent player-selectable second indicia that is also selectable via the unitary touch screen. *Id.* at 11-12.

VI. ISSUES

The issue in this Appeal is whether claims 1-8 are patentable under 35 U.S.C. § 103(a) over Heidel in view of Bruzzese.

VII. GROUPING OF CLAIMS

Claims 1, 2 and 6-8 stand or fall together, and claims 3-5 stand or fall together.

VIII. ARGUMENT

Claims 1-8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Heidel in view of Bruzzese. The rejection should be reversed because the references do not suggest or motivate one of ordinary skill in the art to combine the reference teachings.

A. The Law Of Obviousness

Obviousness requires that all the limitations of a claim must be taught or suggested by the prior art. M.P.E.P. § 2143.03 (citing *In re Royka*, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974)). A *prima facie* case of obviousness requires three basic criteria.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The

teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. (M.P.E.P. § 2143 (citing *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991)))

Although a prior art reference may be modified to meet the claimed limitation, the resultant modified reference is not obvious unless the prior art also suggests or motivates the desirability of the modification. *In re Mills*, 916 F.2d 680, 682, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990) (citing *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)). Obviousness cannot “be established using hindsight or in view of the teachings or suggestions of the invention.” *Ex parte Maguire*, 2002 WL 1801466, *4 (Bd. Pat. App. & Inter. 2002) (Appendix J) (quoting *Para-Ordnance Mfg. Inc. v. SGS Importers Int’l Inc.*, 73 F.3d 1085, 1087, 37 U.S.P.Q.2d 1237, 1239 (Fed. Cir. 1995), *cert. denied*, 519 U.S. 822 (1996)). Further, the proposed modification cannot render the prior art “unsatisfactory for its intended purpose” nor can it “change the principle of operation” of a reference. M.P.E.P. § 2143.01 (citing *In re Gordon*, 733 F.2d at 902, 221 U.S.P.Q. at 1127 and *In re Ratti*, 270 F.2d 810, 813, 123 U.S.P.Q. 349, 352 (C.C.P.A. 1959)).

The law of obviousness requires that a reference be considered as a whole, including those portions that teach away from the Applicant's claimed invention. *See W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.3d 1540, 1550-51, 220 U.S.P.Q. 303, 311 (Fed. Cir. 1983) (“[T]he totality of a reference's teaching must be considered.”); *see also* M.P.E.P. § 2141.02 (stating that prior art must be considered in its entirety including disclosures that teach away from the claims). Indicia of teaching away in a reference gives insight into the question of obviousness. *Monarch Knitting Mach. Corp. v. Sulzer Morat GMBH*, 139 F.3d 877, 885, 45 U.S.P.Q.2d 1977, 1984 (Fed. Cir. 1998). A prior art reference may be considered to teach away when “a person of

ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *Monarch Knitting*, 139 F.3d at 885, 45 U.S.P.Q.2d at 1984 (quoting *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q. 1130, 1131 (Fed. Cir. 1994)).

B. Claims 1-8 Are Patentable Under 35 U.S.C. § 103(a) Over Heidel In View Of Bruzzese

The final Office Action (Appendix D) rejected claims 1-8 under 35 U.S.C. § 103(a) as being unpatentable over Heidel in view of Bruzzese. Heidel is directed to a video lottery terminal having a touch screen and “a number of game control buttons located on the housing of the terminal that can be used along with or instead of the touch screen to control the game.” Heidel, column 1, lines 51-56. The touch screen, in combination with the game control buttons, allows the gaming terminal to be used for a number of different games. *Id.* at column 2, lines 4-8. Bruzzese is directed to a gaming machine having a plurality of spinning reels and a touch screen bonded onto a panel. Bruzzese, abstract.

With regard to claims 1, 2, and 6-8, three grounds are provided – any one of which is sufficient – to prove that a *prima facie* case of obviousness has not been established: (1) the proposed modification changes the principle of operation of Heidel (2) the references teaches away from the proposed modification, and (3) there is no suggestion or motivation to combine the references.

With respect to claims 3-5, in addition to the three grounds listed above, not all of the elements of dependent claims 3-5 are disclosed by the combination of Heidel and Bruzzese.

1. The Proposed Modification Changes The Principle Of Operation Of Heidel

Heidel discloses that touch screens are used to permit a machine to operate more than one game. Heidel, column 1, lines 23-33. Because the multiple games have different functions, it is not possible to use the same set of electromechanical control buttons. *Id.* The use of touch sensitive screens are not well received by many players, however, because, as stated by Heidel, “it has been found that the display of game controls on the video display can significantly slow play in certain circumstances.” Heidel, column 1, lines 34-36. Because the touch screen controls require that “the player to look at the screen and to make hand movements that can be somewhat awkward,” according to Heidel, “the rate of game play and hence the earning potential . . . is reduced.” Heidel, column 1, lines 34-43.

In contrast to touch screens, electromechanical game control buttons facilitate play by touch. This makes game selections physically easier for the player and speeds game play, both of which are desirable to the player. See, for example, Heidel, column 2, lines 53-56, and column 3, lines 35-39.

To overcome the problems identified with touch screens, Heidel proposes to provide “a video gaming machine that is capable of playing a number of different games on a touch screen with a number of game control buttons located on the machine housing that can be used along with or instead of the touch screen to control at least one of the games.” Heidel, column 1, lines 51-56.

The modification proposed by the Office Action to eliminate the electromechanical game control buttons changes the principle of operation of Heidel. The Examiner states that Heidel discloses using either the touch screen or the electromechanical game control buttons for input.

While it is true that Heidel allows for the electromechanical buttons to be disabled *for certain games*, the buttons still exist and are still operable for other games. Heidel's whole intention is to move away from terminals that eliminate electromechanical buttons and solely use touch screens. This is in contrast to the claim language of the present invention, which requires that the non-video portion includes "permanent player-selectable second indicia." *See* claim 1, lines 6-7. To completely eliminate the use or existence of the electromechanical game control buttons flies in the face of the object of Heidel and, thus, is not a proper modification.

2. The References Teach Away From The Proposed Combination

Furthermore, Heidel and Bruzzese teach away from each other. As discussed above, Heidel lists multiple reasons as to why using solely a touch screen on a gaming terminal is not well received by players. According to Heidel, using only a touch screen eliminates the use of touch when playing the game, slowing down the game and aggravating players. Using only electromechanical buttons, however, limits the number of different games that can be played on a single machine. Heidel's solution is to provide both a touch screen and electromechanical buttons.

In contrast, Bruzzese's objective is to provide a mechanical spinning reel that utilizes solely touch screen controls. Bruzzese, column 1, lines 52-54. Bruzzese advocates completely eliminating the electromechanical game controls to reduce manufacturing costs, stating that "there will be savings in the manufacturing unit cost of such a gaming machine because the cost of implementation of the touch screen circuitry will be less than the cabinet work, circuitry and components of the conventional button controls that are replaced." Bruzzese, column 2, lines 19-23. Thus, the objective of Bruzzese is completely at odds with the objective of Heidel. A person

of ordinary skill in the art would not have looked to combine the features of these two references, since they directly contradict each other.

3. No Suggestion Or Motivation To Combine The References

As stated above, in order to prove a *prima facie* case of obviousness, there must be a motivation or suggestion to combine the references. The Examiner has not presented any such motivation or suggestion. The Examiner states that it would have been obvious to “employ the touch screen technology of Bruzzese over the non-video {electromechanical buttons} of Heidel in order to make the buttons easier to operate by making them touch sensitive.” December 16, 2003, Office Action. As stated above, however, Heidel teaches that the electromechanical buttons should *not* be touch sensitive. By including a touch screen over the electromechanical buttons, the purpose of including the buttons is obviated. Neither Heidel nor Bruzzese provide any suggestion or motivation to be combined with the other, because, as stated above, they are directly at odds with one another.

4. Claims 3-5 Are Not Taught Or Suggested By The Combination Of Heidel And Bruzzese

Assuming *arguendo* that claim 1 is not patentable (despite the evidence above), dependent claims 3-5 should be patentable if rewritten in independent form. Claim 3 is dependent on claim 1 and adds the limitation that the non-video portion includes an artwork panel. Because claim 3 is dependent on claim 1, it also includes the limitations that the touch screen overlaps the non-video, artwork panel.

Neither Heidel nor Bruzzese teach or suggest such a limitation. There is no teaching in either reference that a touch screen panel should extend over an artwork panel. The Examiner stated that Bruzzese teaches artwork on a non-video portion and that it would be obvious to

include the artwork of Bruzzese into the application of Heidel. Neither reference, however, discloses placing the touch screen over the artwork. Because the Examiner has failed to disclose every limitation of the claim, claim 3 and its dependents 4 and 5 should be allowable over the prior art.


Furthermore, the artwork panel as described in the specification is fixed, and the touch screen merely overlays the fixed artwork. As shown in FIG. 3, the touch screen 12 overlays the artwork. This artwork is fixed and specific to the particular gaming terminal 10. Bruzzese directly teaches away from having fixed artwork. Bruzzese teaches that “a particular advantage of the invention...is that there is great flexibility in the configuration of mechanical spinning reel machines.” Bruzzese, col. 2, lines 11-14. Therefore, the combination of Heidel and Bruzzese would not disclose a touch screen that extends over fixed artwork.

IX. CONCLUSION

For at least the foregoing reasons, the final rejection of appealed claims 1-8 set forth in the Office Action mailed December 16, 2003, should be reversed.

Respectfully submitted,

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Cynthia K. Thompson
Reg. No. 48,655
Jenkins & Gilchrist
225 West Washington Street, Suite 2600
Chicago, IL 60606-3418
(312) 425-3900
Attorney for Applicants



Pending Claims
U.S. Patent Application No. 09/821,195

1. (Previously Presented) A gaming machine controlled by a processor in response to a wager, said gaming machine comprising:
 - a display including a video portion and a non-video portion; and
 - a unitary touch screen overlapping both said video portion and said non-video portion, said video portion including player-selectable first indicia selectable via said unitary touch screen and said non-video portion including permanent player-selectable second indicia selectable via said unitary touch screen.
2. (Original) The gaming machine of claim 1, wherein said video portion and said non-video portion are immediately adjacent each other.
3. (Original) The gaming machine of claim 1, wherein said non-video portion includes an artwork panel.
4. (Original) The gaming machine of claim 3, wherein said second indicia are selectively illuminated by lights located behind said artwork panel to indicate which of said second indicia are active and can be selected by a player.
5. (Original) The gaming machine of claim 3, wherein said second indicia are printed on said artwork panel.
6. (Original) The gaming machine of claim 1, wherein said second indicia are selected from a group consisting of a "Spin Reels" button, a "Bet Per Line" button, a "Max Bet Spin" button, a "Select Lines" button, a "Collect" button, a "Help" button, and a "Pay Table" button.
7. (Original) The gaming machine of claim 1, wherein said non-video portion is located below said video portion.

8. (Original) The gaming machine of claim 1, wherein said first indicia vary in at least one of location and function depending upon a segment of a game being played on the gaming machine.



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• **Shelley, Scott Paul**
New South Wales 2233 (AU)

(30) Priority: **06.02.1996 AU PN7929/96**

(74) Representative: **White, Martin David**
MARKS & CLERK,
57/60 Lincoln's Inn Fields
London WC2A 3LS (GB)

(72) Inventors:
• **Bruzzese, Vincent Carmelo**
New South Wales 2116 (AU)

(54) **A gaming machine**

(57) A gaming machine (30) is disclosed, the machine (30) having a plurality of spinning reels (18) viewed through a flat transparent panel (32). Touch screen circuitry (34) is bonded with said panel (32) and forms an array of "touch points" or data inputs by which game operation can be effected.

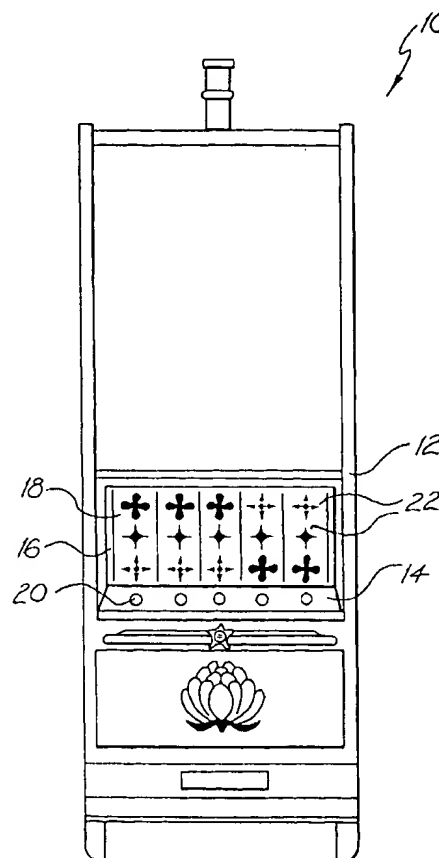


FIG. 1

Description

Field of the invention

This invention relates to a gaming machine, and particularly to a gaming machine of the type for individual play that typically is known as a 'slot machine', 'fruit machine', 'poker machine', or the like. The invention particularly relates to a gaming machine of the type having mechanical spinning reels (typically 3 to 5 in number) that, in the play of a game, are set spinning by the player and after a predetermined period of time come to a halt, with the result of the play depending upon the displayed combination of the indicia on each reel along horizontal and/or diagonal 'win lines'.

Background of the invention

Mechanical spinning reel gaming machines are well known, and are commonly referred to within the industry as 'stepper' machines because of being implemented by use of electrical stepper motors. Mechanical reel gaming machines are operable by player-activated pushbutton controls and/or a mechanical arm.

Gaming machines that utilise a video monitor to graphically represent the spinning reels also are well known. Such gaming machines similarly incorporate pushbutton controls, although more recently provide for touch screen control by means of controls bonded to the outer surface of the video monitor. There are difficult technical problems associated with bonding touch screen controllers to curved video monitor screens, requiring the use of packing materials at the edge margins and sophisticated data processing techniques to ensure a regular array of touchable screen 'points' and linearity between such points.

Even though video gaming machines utilise more technologically advanced component parts, there still is a significant demand amongst players of gaming machines for the older-style spinning reel machine.

The present invention broadly provides a mechanical spinning reel gaming machine that incorporates touch screen controls.

Summary of the invention

Therefore, in one broad form, the invention discloses a gaming machine comprising one or more mechanical spinning game reels, a flat transparent panel located in front of the reels and through which the reels can be viewed, touch screen circuitry bonded to the flat panel, and control means for receiving signals from the touch screen circuitry and controlling the play of a game, including spinning of the reels.

In one preferred form, the touch screen circuitry can be bonded to the exterior surface of the panel. Alternatively, the touch screen circuitry can be applied to the interior surface of the panel. The gaming machine can

be mounted in a cabinet or housing, with the panel forming a component part of the exterior surface of the cabinet or housing.

In a particularly preferred form, a graphical transfer also can be attached to the panel. The transfer most preferably will be attached to the interior surface of the panel.

The invention further discloses a gaming machine assembly comprising a flat transparent panel and touch screen circuitry applied to a surface of the panel.

A particular advantage of the invention arises for the gaming machine manufacturer, in that there is great flexibility in the configuration of mechanical spinning reel machines that was not otherwise easily achievable. Furthermore, there are significant commercial advantages for the manufacturer given that it is believed there will be great player acceptability of gaming machines embodying the invention. It is also believed that there will be savings in the manufacturing unit cost of such a gaming machine because the cost of implementation of the touch screen circuitry will be less than the cabinet work, circuitry and components of the conventional pushbutton controls that are replaced.

Brief Description of the Drawings

An embodiment of the invention now will be described with reference to the accompanying drawings, in which:

- Fig. 1 is a front view of a conventional mechanical spinning reel gaming machine;
- Fig. 2 is a schematic block diagram of a gaming machine embodying the present invention;
- Fig. 3 is a cross-sectional view of the screen of the gaming machine of Fig. 2;
- Fig. 4 is a front view of the touch screen of Fig. 3;
- Figs. 5 and 6 show the mechanical arrangement of the touch screen circuitry applied to the flat screen of the gaming machine; and
- Figs. 7a to 7b are component schematic block diagrams of the touch screen controller unit.

Description of Preferred Embodiments and Best Mode

Fig. 1 shows a conventional (prior art) mechanical spinning reel gaming machine 10 that includes a housing (or cabinet) 12, a control panel 14, and a front flat screen 16, usually fabricated from glass or a transparent plastics material, and behind which (ie. inside the cabinet) is located the mechanical spinning reel assembly 18. The operation of the gaming machine 10 is by an electronic controller (not shown) located within the cabinet 12 and having connection with the control panel 14 and the spinning reel assembly 18.

As is well known, the play of the gaming machine 10 occurs by the player typically selecting the number

of units to be wagered by means of one(s) the pushbuttons 20, and possibly also the number of "win lines" to be activated, followed by activation of the "play" push-button. The controller then causes the individual reels 22 to be set into spinning motion and to stop at predetermined times, with the outcome of that player of the game being represented by the indicia appearing along the win line(s).

Referring now to Figs. 2-4, a gaming machine 30 embodying the invention will now be described. As with a conventional mechanical spinning reel gaming machine, the present gaming machine 30 has a flat front screen 16. As particularly shown in Fig. 3, the flat screen 16 has bonded to it touch screen circuitry 34, in this case conveniently being to the side of the glass 16 external of the cabinet 12. The configuration and bonding process will presently be described.

The rear side of the flat screen 16 has attached to it an adhesive graphic transfer 36. The location of a graphical display 38 behind the transfer 36 can be best seen in Fig. 3. As particularly shown in Fig. 4, a player of the gaming machine 30 is presented with a view through the flat screen 16 of the transfer 36 displaying indicia/icons that are co-located with particular 'touch points' of the touch screen assembly 34 that correspond with the illustrated function (for example "collect", "reserve", etc). Two lower window portions 40, 42 of the graphical transfer 36 allow the graphical display 38 to be viewed, by which information concerning available credits and other game functions, instructions or advertising (for example) can be presented to the player. Five upper windows 44-52 allow each of the spinning reels 18 to be viewed by the player.

Therefore, in play of the gaming machine 30, a player presses the screen 32 at a 'touch point' in the region of the desired displayed indicia/icons to effect the respective machine operation, that action being signalled by the touch screen assembly 34 to a game controller, as presently will be described. The game controller then causes the reels 18 to spin, stopping the reels after a predetermined time and displaying or otherwise indicating to the player the result of that play of the game.

Returning to the schematic block diagram of Fig. 2, the touch screen assembly 34 connects to a touch screen controller unit 60 by an interconnecting cable 62 carrying analog data. The controller can be such as the present applicant's assembly No. 754-239-00 controller. In turn, the touch screen controller connects with a game microprocessor assembly 64 on a bus 66 that operates under a proprietary serial protocol, known as "Netplex". The game microprocessor assembly 64 can be such as the present applicant's 80960 game controller (assembly no. 755-085-00). The game microprocessor assembly 64 has control over the stepper motors and sensor optics 65 for the spinning reel assemblies and the graphical display 38. Yet further, the microprocessor assembly 64 has connection with I/O board 68 by a cable 70 under control of a proprietary interface known as "Senet". The

I/O board 68 can be such as the present applicant's assembly No. A33-006-14 I/O board. The I/O board 68 has control over the machine peripheral equipment, including buttons, lights and electromechanical meters.

Representative details of the touch screen assembly 34 and touch screen controller 60 are included in US Patent Application Serial No. 08/294,227 (equivalent to Australian Patent Application No. 24957/95 owned by the parent corporation of the present applicant), the contents of which are incorporated herein by cross-reference.

Referring to Figs. 5 and 6, fabrication of the touch screen assembly 36 applied to the flat screen 16 will be described. In this embodiment, the screen 16 is constructed of glass and is approximately 500 mm in length, 340 mm in height and 5 mm thick. Four electrodes 80 are screened onto the glass panel 16 with a silver frit glass mixture. The electrodes are constructed of a conductive material suitable for the soldering of attachment wires 90-96 by use of a low temperature solder 82. A representative length of the top and bottom electrodes is 290 mm, with a separation of 320 mm. The length of the left side and right side electrodes is 245 mm with a separation of 480 mm.

A conductive coating of Indium Tin Oxide (ITO) 84 of approximately 700 ohms/sq is applied over the top of the electrodes 80 by a vacuum deposition process. A protective hard coat of silicon dioxide 80 then is placed over the ITO layer to protect the ITO layer 84 from scratching and to provide electrical insulation. The coating preferably is to a thickness of 20,000 Angstroms.

For a configuration of the dimensions described, the useable area of the flat screen 16 for touch screen operation is about 25 cm x 40 cm, this being the area between the electrodes. The touch screen assembly 34 of the dimensions described typically results in a 5 x 7 array of discrete 'touch points'. Finally, an edge shielding (not shown) is placed around the perimeter of the glass screen 16 to isolate the touch screen assembly 34 from surrounding conductive material, and further to reduce the incidence of leakage currents that might otherwise cause spurious signals that might be mistaken for a "touch".

Referring now to Figs. 7a-7f, further details of the touch screen controller unit 60 will be given. The touch screen assembly 34 connects with the touch screen controller unit 60 by a cable 62 as has previously been described. The cable can be a four conductor shielded cable, such as the part no. 9534 manufactured by Belden Cable of the United States.

As particularly shown in Fig. 7a, the electrodes 80 each are A.C. coupled to a differential amplifier stage 100 via 10 uF capacitors. The differential amplifier stage consists of four separate amplifiers. The gain of each amplifier is 2000. The amplifiers amplify the difference between the 11.0592 kHz signal sent to the 'Screen Drive 0' (described presently) and the signal returning from the touch screen circuitry 34. The output of the dif-

ferential amplifier is A.C. coupled to the four Bessel band pass filters 102-108. The gain of the Bessel band pass filter stage is about 6, and the stage filters out any signal that is not within the pass band frequency of the filter. The center of the Bessel band pass filter stage is set to the same frequency as the screen drive 11.0592 kHz.

As shown in Fig. 7f, a Dallas 80C320 microprocessor crystal 16 is divided down from 22.1184 MHz into two frequencies. One of the frequencies is used to clock the Bessel band pass filter stage. This frequency is 100 times the center frequency of the Bessel band pass filter stage, and is 1.10592 MHz. The other frequency is 11.0592 kHz. This frequency is A.C. coupled to the auto gain control circuitry 110 shown in Fig. 7e which is controlled by a Dallas 80C320 microprocessor 130. The microprocessor changes the gain of the auto gain control circuitry 110 so proper screen drive is accomplished. The output of the auto gain control circuitry 110 is connected to a second order Butterworth low pass filter 112, that is used to remove some of the higher order harmonics from the auto gain control circuitry 110. The -3dB point on the low pass filter is set at approximately 11 kHz. The signal out of the low pass filter 112 is A.C. coupled to 'Screen Drive 0', and D.C. coupled to the differential amplifier stage 100.

The four outputs from the Bessel band pass filter stages 102-108 are connected to a channel multiplexer 120, as shown in Fig. 7c. The microprocessor 130 controls the output of the channel multiplexer, which is connected to an analog buffer 122. The analog buffer has a gain of -1, and its output is connected to a analog-to-digital converter 124.

As shown in Fig. 7f, the microprocessor 130 is supported by several I.C.s. The system RAM 132 is an 8k by 8 in which the boot program is stored. The system program is stored in two different I.C.s. The size of the EPROM is 32k by 8, however only the first 8k by 8 bites are used. The main program and calibration data is stored in the FLASH memory I.C. 136. The watch dog timer I.C. 138 is used to reset the microprocessor 130 if it fails to execute the instructions properly. The interface 140 of the "NETPLEX" is isolated, and is the present applicant's 960 NETPLEX Interface. Additional I.C.s 142,144 are used for memory decoding, address latching, and signal conditioning.

Operation of the gaming machine 30 otherwise proceeds as is conventionally the case.

Claims

1. A gaming machine comprising one or more mechanical spinning game reels; a flat transparent panel located in front of the reels and through which the reels can be viewed; touch screen circuitry bonded to the flat panel; and control means for receiving signals from the touch screen circuitry and

controlling the play of a game, including spinning of the reels.

2. A gaming machine as claimed in claim 1, wherein said touch screen circuitry includes at least one pair of electrodes located at opposed edge margins of said panel, said electrodes being driven to produce an array of discrete regions on said panel defining input points.
3. A gaming machine as claimed in claim 2, wherein said touch screen circuitry is applied to the exterior surface of said panel.
4. A gaming machine as claimed in claim 3, further comprising a graphical transfer attached to the interior surface of said panel, the transfer permitting a view of said reels.
5. A gaming machine as claimed in any one of claims 1 to 4 further comprising a cabinet housing said reels and said control means, and wherein said panel forms a component part of the exterior surface of said cabinet.
6. A gaming machine assembly comprising a flat transparent panel and touch screen circuitry applied to a surface of said panel.
7. A gaming machine assembly as claimed in claim 6, wherein said touch screen circuitry includes at least one pair of electrodes located at opposed edge margins of said panel, said electrodes being driven to produce an array of discrete regions on said panel defining input points.
8. A gaming machine assembly as claimed in claim 7, wherein said touch screen circuitry is applied to the exterior surface of said panel.

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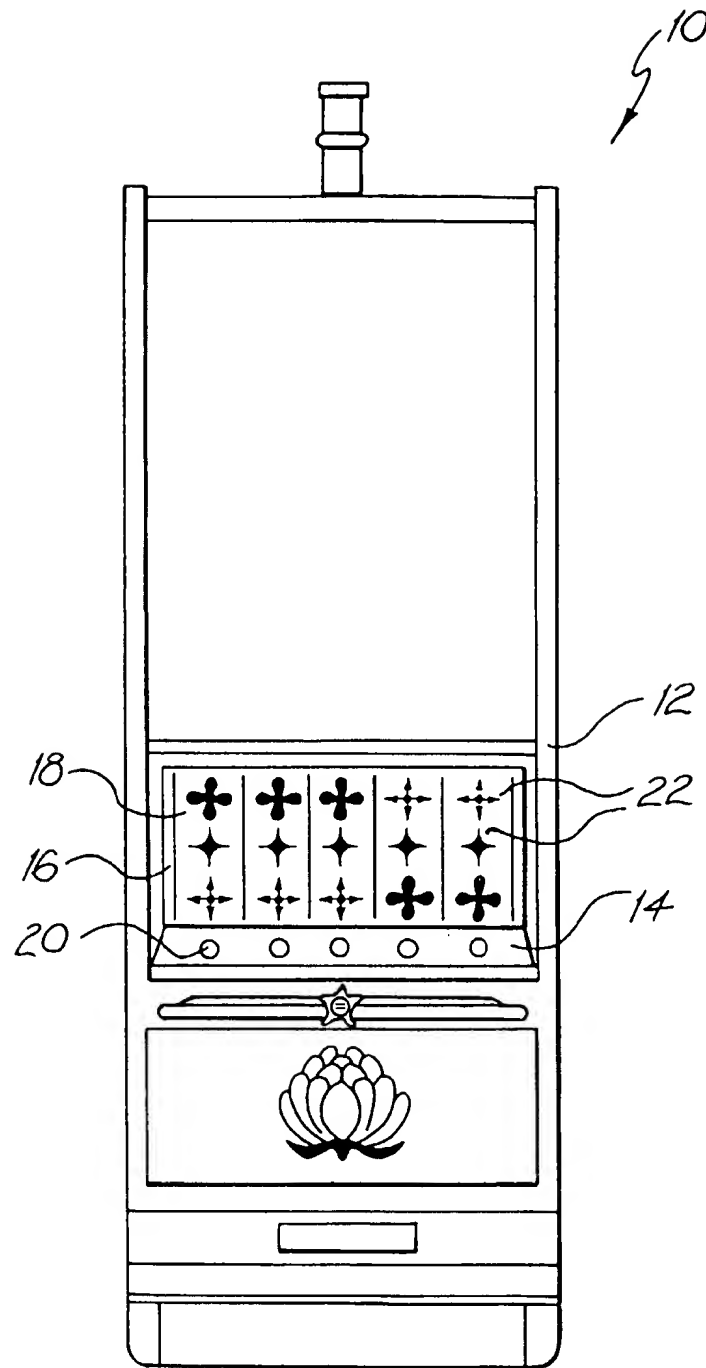


FIG. 1

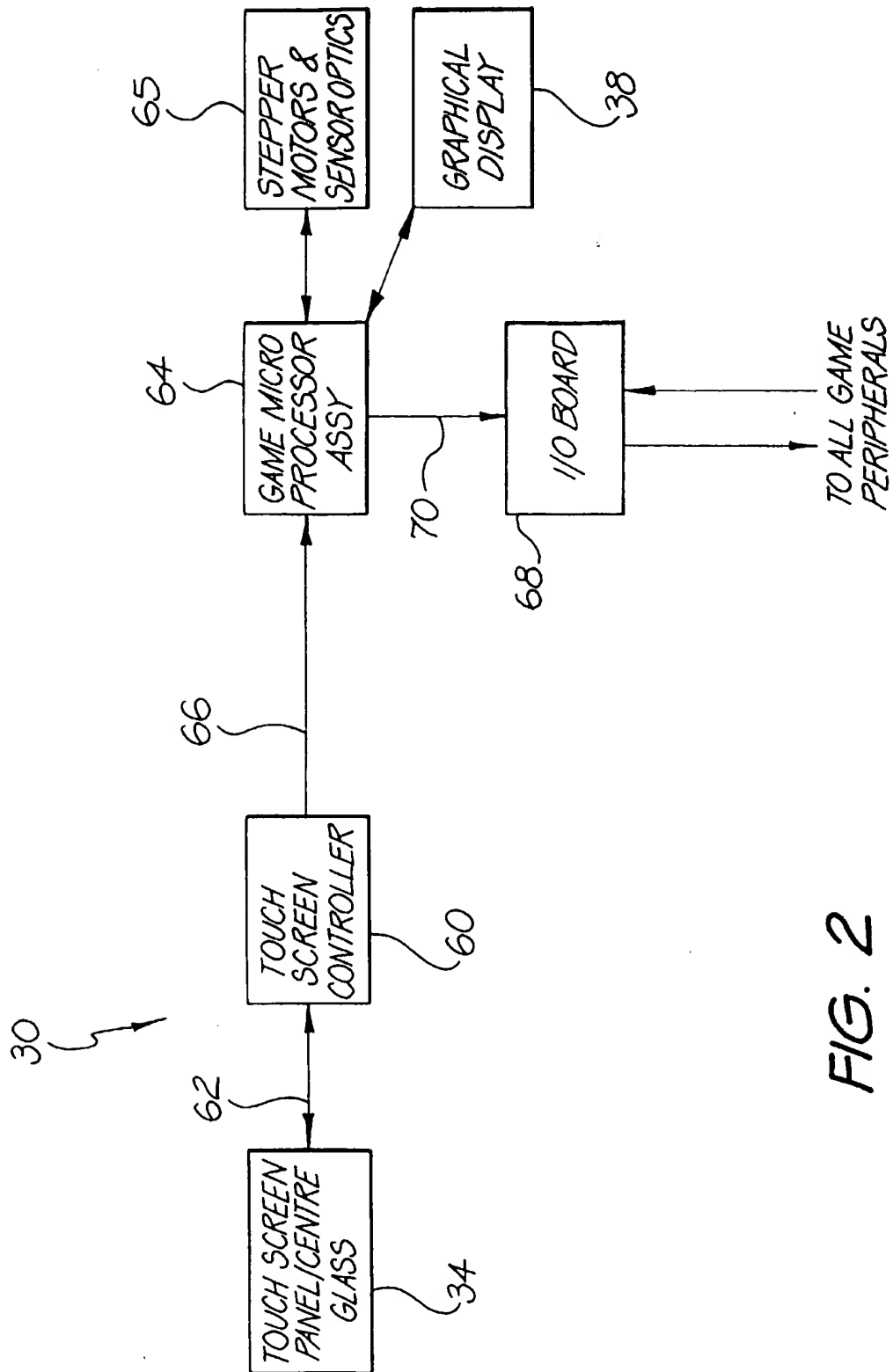


FIG. 2

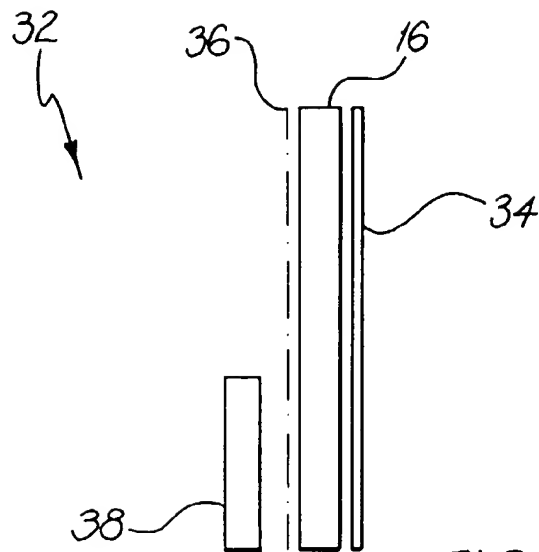


FIG. 3

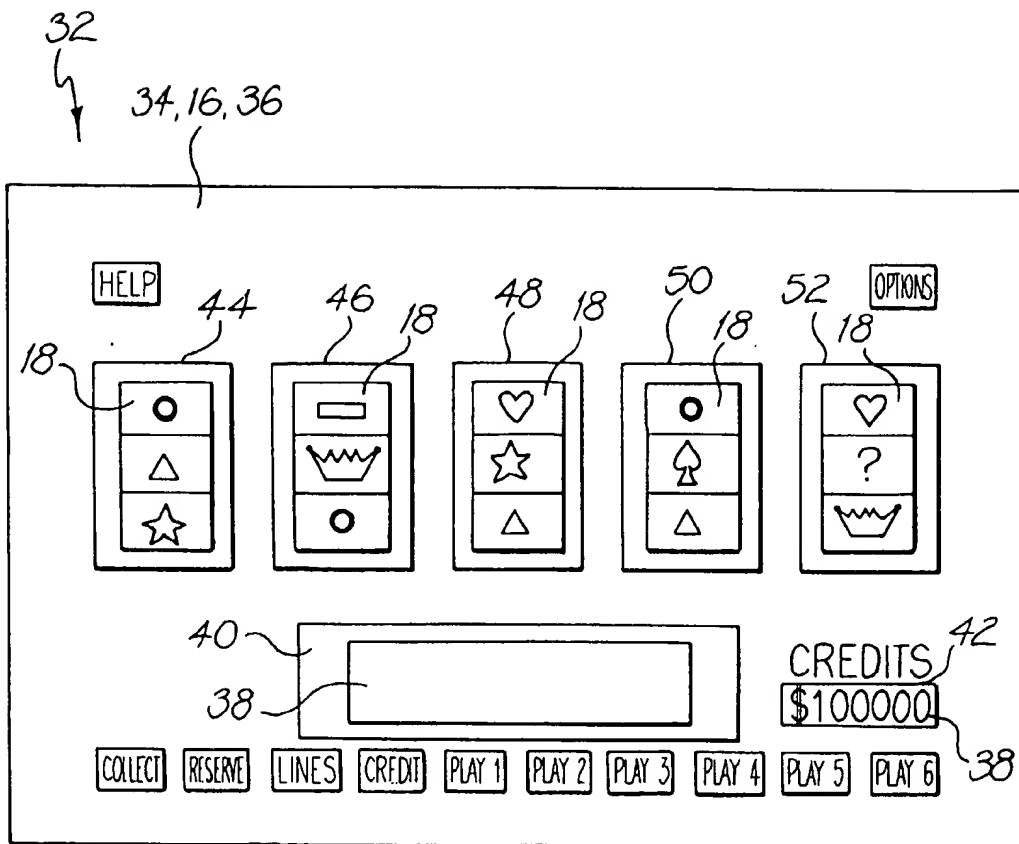


FIG. 4

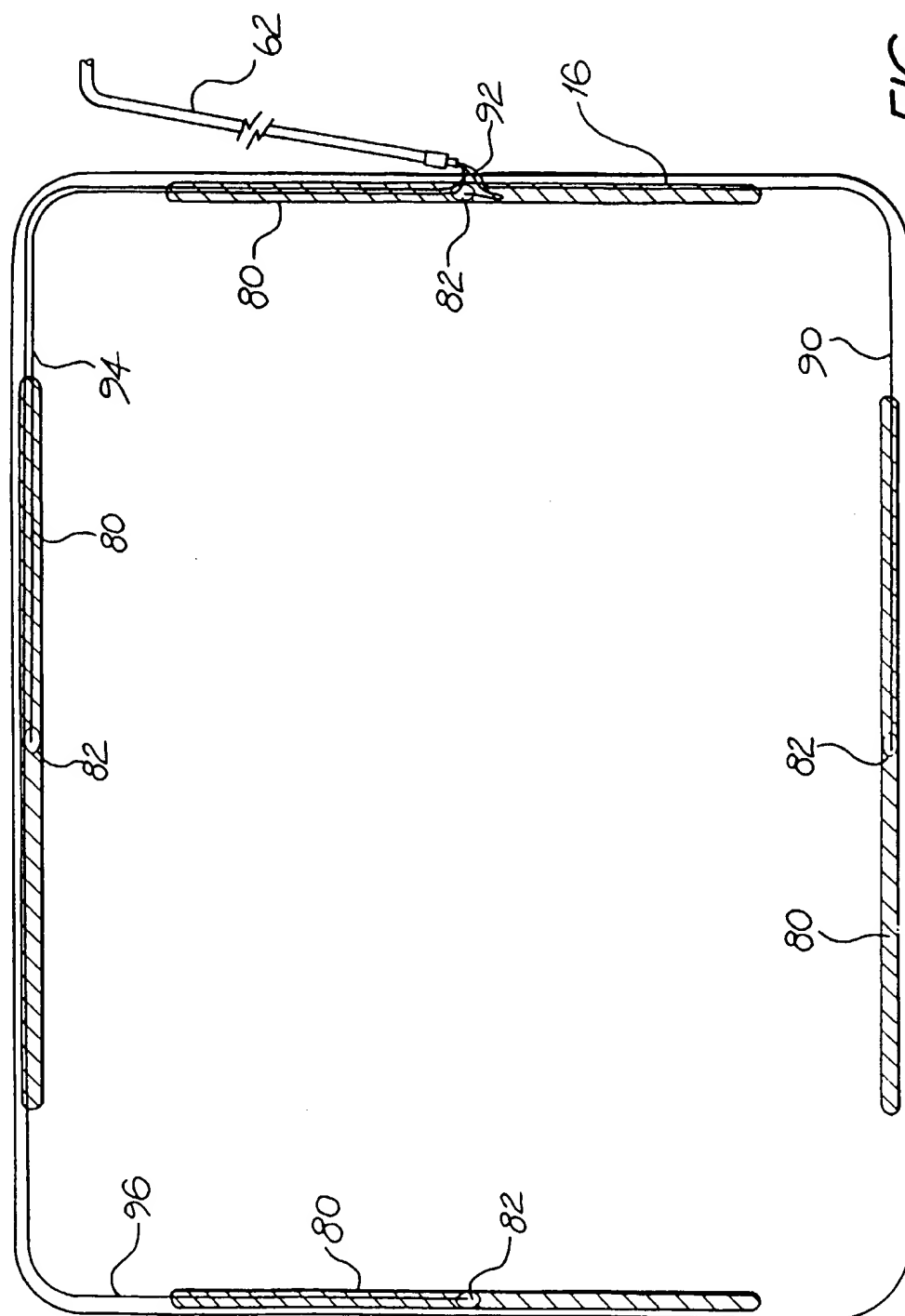


FIG. 5

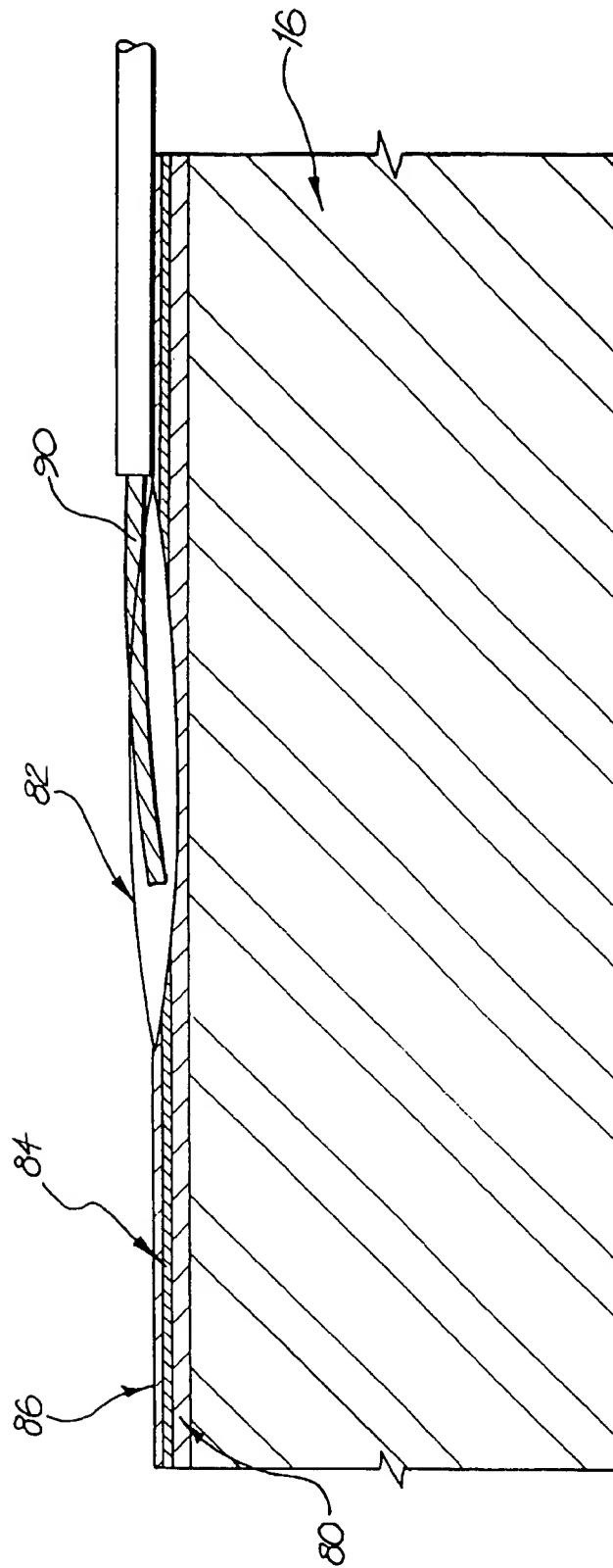


FIG. 6

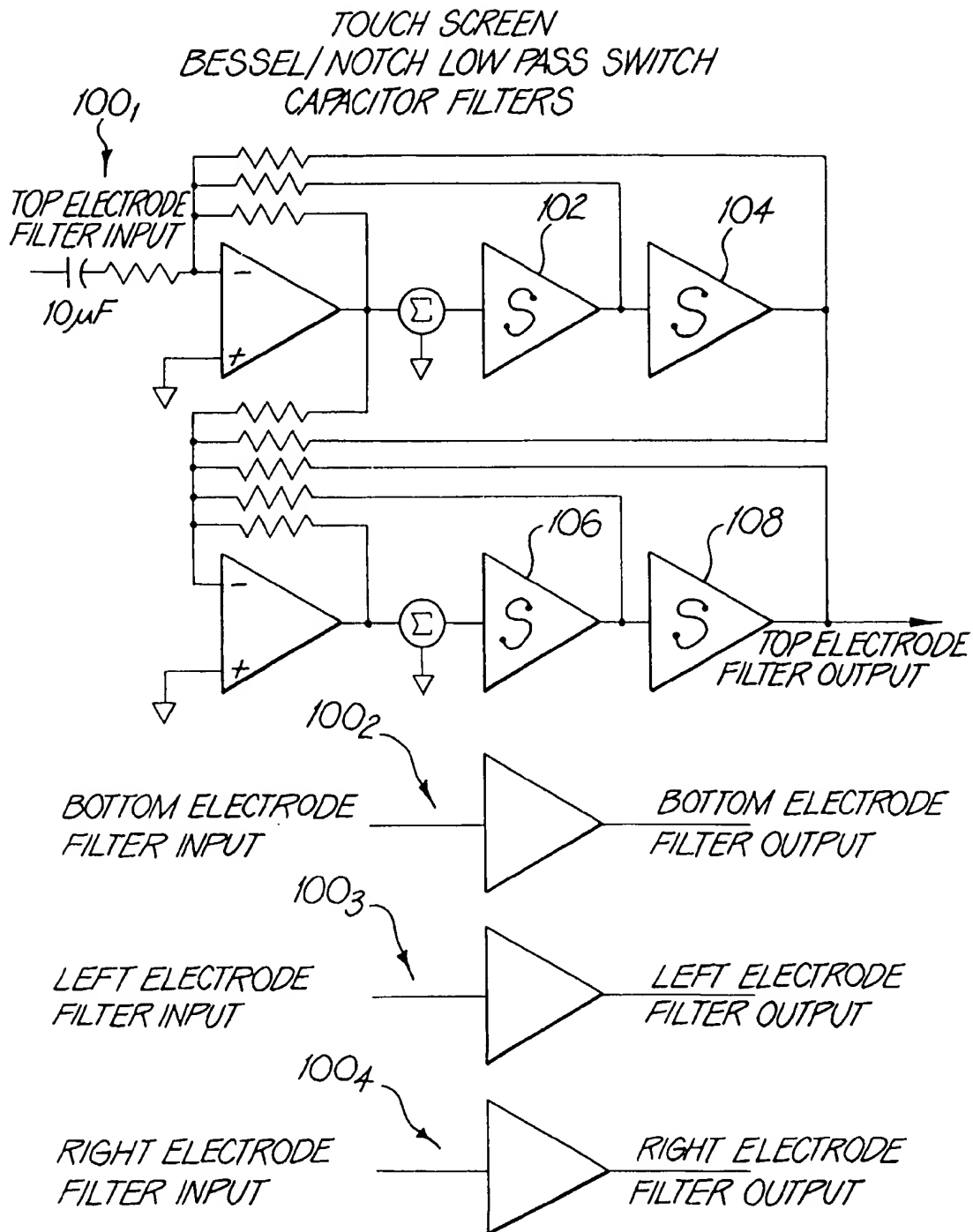


FIG. 7a

TOUCH SCREEN POWER
SUPPLY BLOCK DIAGRAM

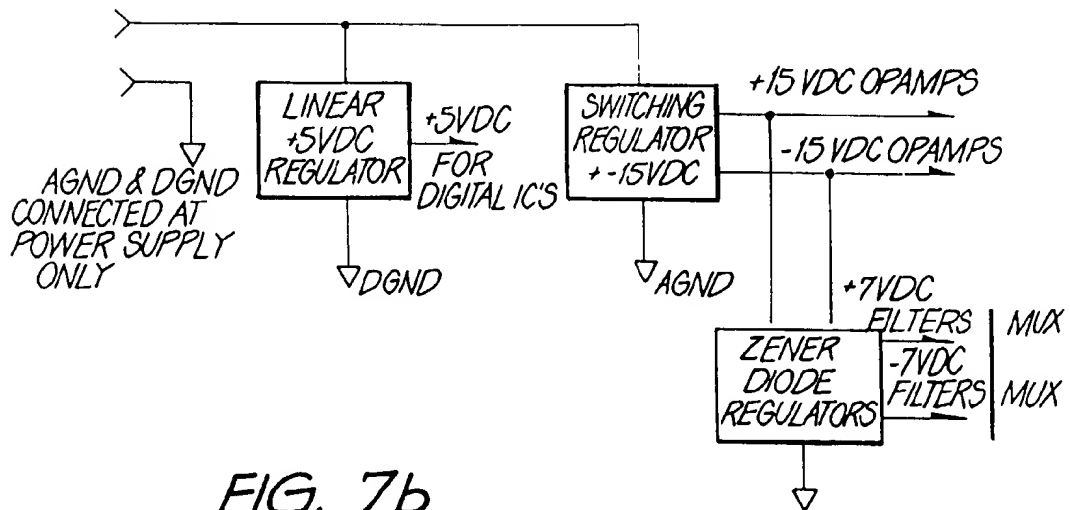
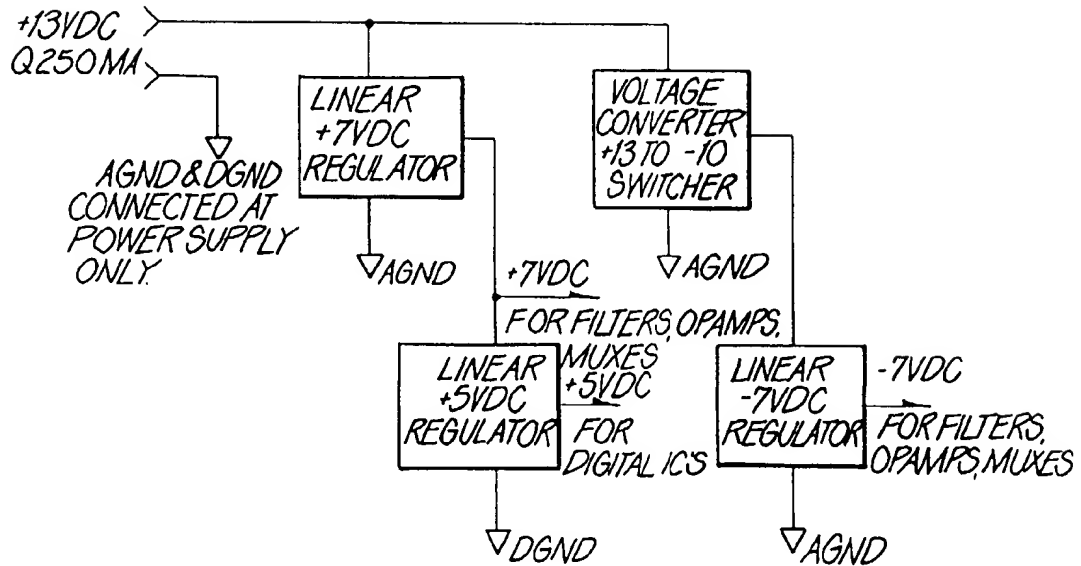


FIG. 7b

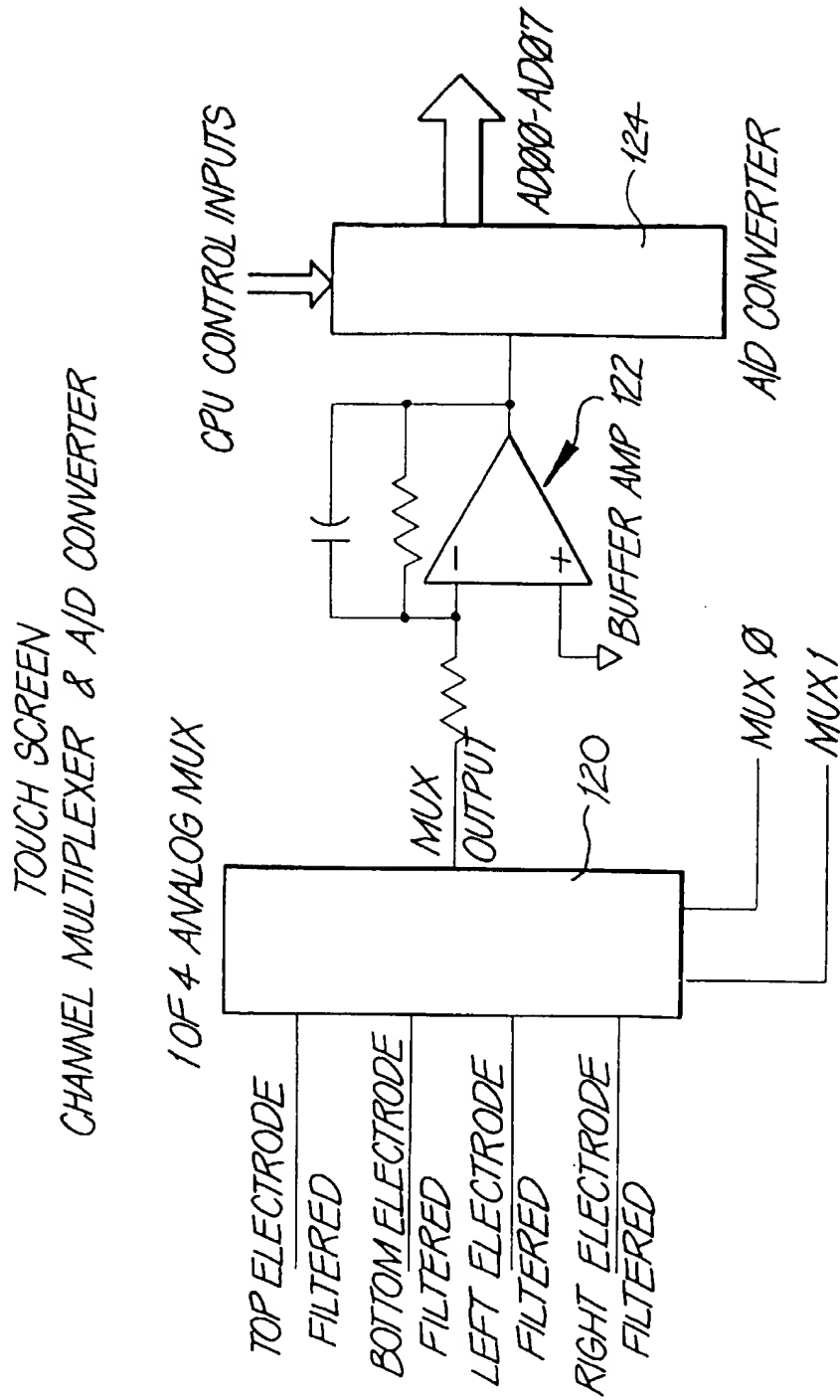
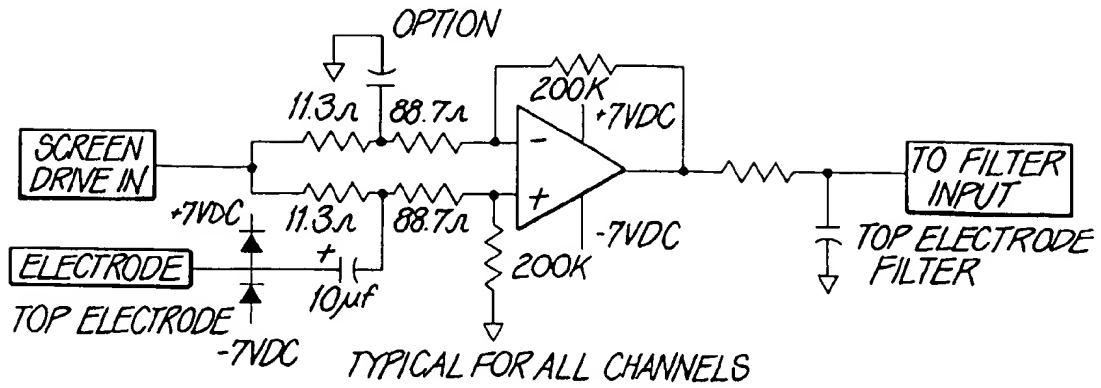


FIG. 7C

TOUCH SCREEN INPUT OPAMPS



(BOTTOM ELECTRODE)



(LEFT ELECTRODE)



(RIGHT ELECTRODE)



FIG. 7d

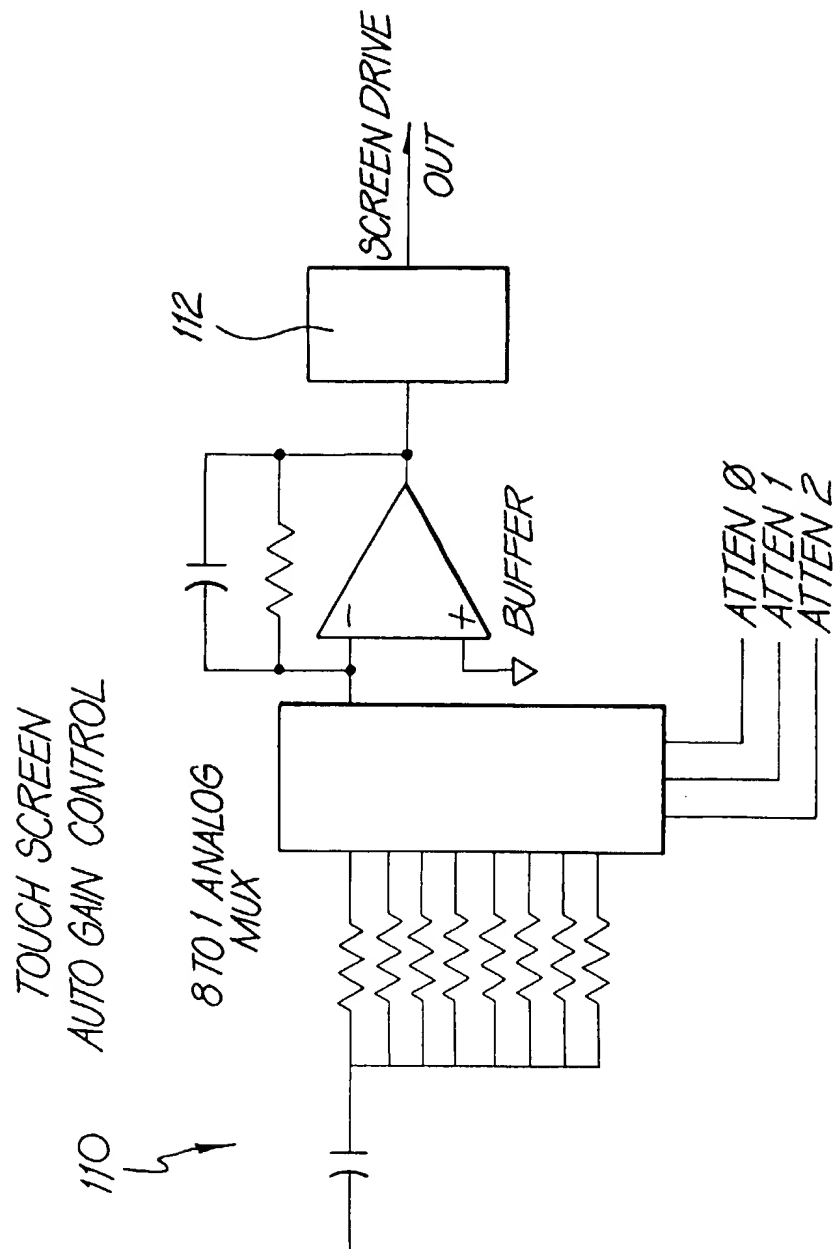


FIG. 7e

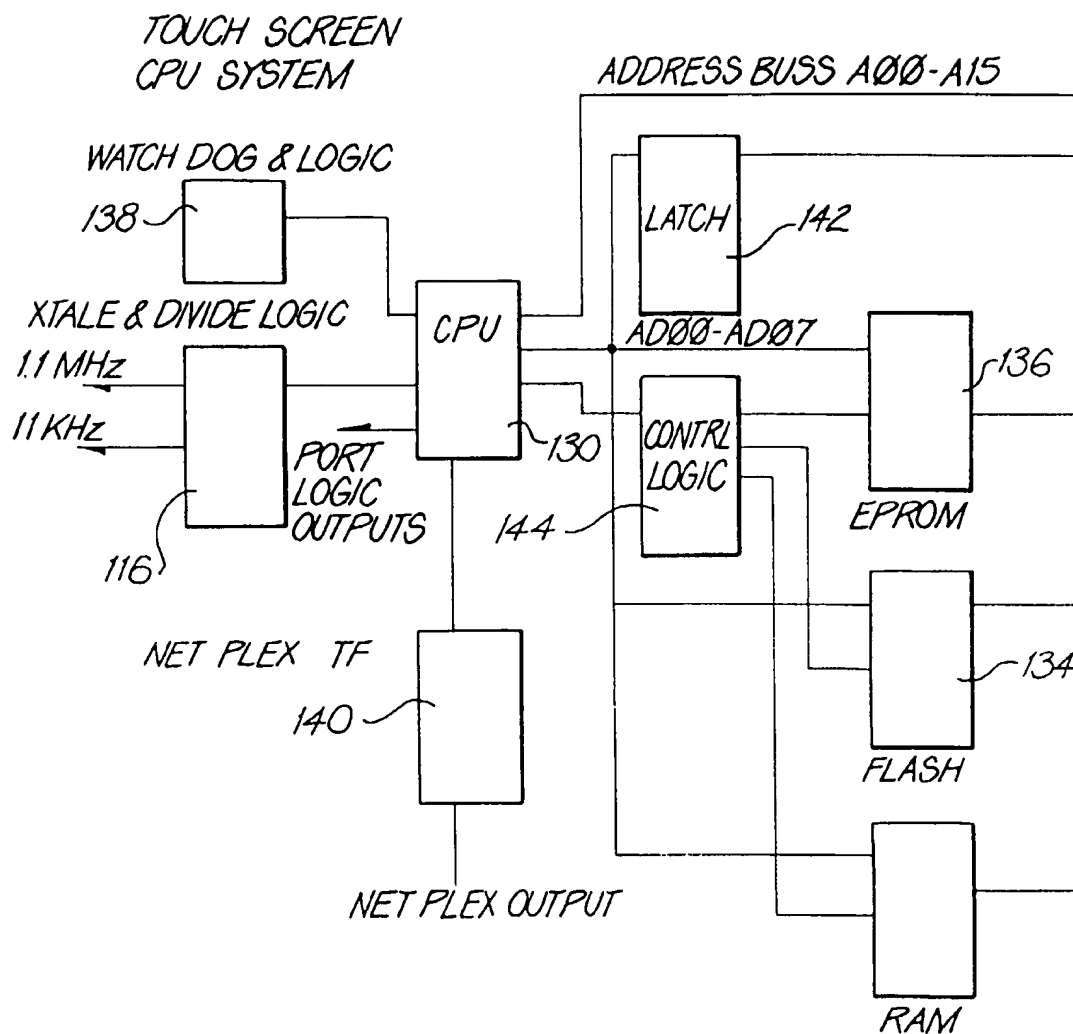


FIG. 7f



European Patent
Office

EUROPEAN SEARCH REPORT

Application Number
EP 97 30 0735

DOCUMENTS CONSIDERED TO BE RELEVANT			
Category	Citation of document with indication, where appropriate, of relevant passages	Relevant to claim	CLASSIFICATION OF THE APPLICATION (Int.Cl.6)
X	GB 2 251 112 A (BARCREST)	1,5,6	G07F17/32
Y	* the whole document *	2,3,7,8	

Y	EP 0 544 300 A (SHARP)	2,3,7,8	
A	* column 1, line 16 - column 2, line 42; figures 6-10 *	1,6	

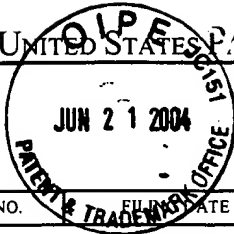
X	EP 0 588 625 A (BARCREST)	6	
A	* abstract; figure *	1,3,5,8	

			TECHNICAL FIELDS SEARCHED (Int.Cl.6)
			G07F G06K
The present search report has been drawn up for all claims			
Place of search		Date of completion of the search	Examiner
THE HAGUE		21 May 1997	Neville, D
CATEGORY OF CITED DOCUMENTS			
X : particularly relevant if taken alone Y : particularly relevant if combined with another document of the same category A : technological background O : non-written disclosure P : intermediate document		T : theory or principle underlying the invention E : earlier patent document, but published on, or after the filing date D : document cited in the application L : document cited for other reasons & : member of the same patent family, corresponding document	

EPO FORM 1501 01/92 (P04/01)



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,195	03/29/2001	Timothy C. Loose	47079-00086	4522

30223 7590 12/16/2003
JENKENS & GILCHRIST, P.C.
225 WEST WASHINGTON
SUITE 2600
CHICAGO, IL 60606

EXAMINER

WHITE, CARMEN D

ART UNIT PAPER NUMBER

3714

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,195

Applicant(s)

LOOSE ET AL.

Examiner

Carmen D. White

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Heidel*** et al (5,342,047) in view of ***Bruzzese*** (EP 0 789 338).

Regarding claims 1-2 and 6-8, Heidel teaches a gaming machine controlled by a processor in response to a wager, said gaming machine comprising a display including a video portion (Fig. 1, #12) and a non-video portion (Fig. 1, #34); and a touch screen overlapping the video portion; said video portion including player-selectable first indicia selectable via said touch screen and the non-video portion including permanent player selectable second indicia selectable via the touch screen (abstract; Fig. 1). While Heidel teaches a gaming machine with video and non-video portions and a touch screen overlapping the video portion of the machine, Heidel lacks disclosing a touch screen overlapping the non-video portion of the machine. In an analogous gaming machine, Bruzzese teaches the bonding of a touch panel to an existing non-video {mechanical reel portion} of a gaming machine (abstract; col. 1, lines 47-58). It would have been obvious to a person of ordinary skill in the art at the time of the invention to employ the touch screen technology of Bruzzese over the non-video {electromechanical

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buttons} of Heidel in order to make the buttons easier to operate by making them touch sensitive. This would allow for quicker input by the players.

Regarding claims 3-5, Heidel and Bruzzese teach all the limitations of the claims as discussed above. Heidel further teaches the use of lights to illuminate the second indicia buttons (col. 3, lines 55-67). Heidel lacks the explicit disclosure of artwork on the non-video portion. Bruzzese teaches the feature of artwork on a non-video portion of a gaming machine (Fig. 1). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature of artwork, taught by Bruzzese, in Heidel in order to make the gaming machine more aesthetically pleasing; thereby, attracting more players and increasing gaming profits.

Examiner's Response to Applicant's Remarks

Applicant argues that the *electromechanical game control buttons are required by Heidel's invention and to eliminate them would render Heidel unsatisfactory for its intended purposes*. The examiner disagrees with Applicant's assertion that the control buttons are required by Heidel. Heidel teaches that the electromechanical buttons or the touch screen can be used for input (col. 1, line 55). Therefore, Heidel is functionally capable of performing its intended purposes with or without the electromechanical buttons. Applicant further argues that the combination/modification of Heidel with Bruzzese changes Heidel's principle of operation. The examiner disagrees with this argument made by applicant. As mentioned above, Heidel does not need electromechanical input in order to operate (i.e. receive player controlled inputs for operating the gaming device). Further, since Heidel teaches the use of only touch

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screen input, if desired, it is clear that Heidel can operate with or without the buttons.

Applicant argues that the references teach away from each other and that there is no motivation or suggestion to combine. Again, the examiner disagrees with this argument made by Applicant. Heidel and Bruzzese are both in the video gaming machine art and both teach the use of touch screen technology to modify existing slot machine features in order to enhance player input into the gaming machine. Therefore, the examiner has maintained the prior art rejection, above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

USPTO Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-

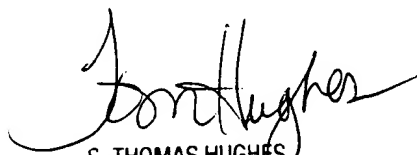
Art Unit: 3714

5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-

1148


S. THOMAS HUGHES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 09/821,195 Confirmation No. : 4522
Applicant : Timothy C. Loose et al.
Filed : March 29, 2001
Title : GAMING MACHINE WITH AN OVERHANGING TOUCH SCREEN

T.C./A.U. : 3714
Examiner : Carmen D. White

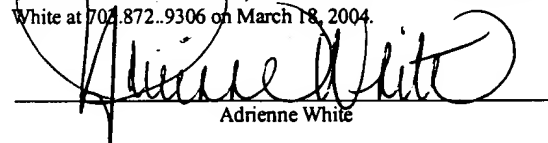
Docket No. : 47079-00086USPT
Customer No. : 30,223

**REPLY AFTER THE FINAL ACTION MAILED
DECEMBER 16, 2003 PURSUANT TO 37 C.F.R. § 1.116**

MAIL STOP AFTER FINAL
COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the attached paper was submitted to the
Commissioner for Patents, via facsimile to Examiner Carmen
White at 702.872.9306 on March 18, 2004.


Adrienne White

Dear Commissioner:

This paper is submitted in reply to the Final Office Action mailed December 16, 2003 for which the three-month date for response is March 16, 2004. The Applicants have enclosed a Petition For Extension Of Time Under 37 C.F.R. § 1.136(a) for extending the due date for the present reply up to and including April 16, 2004. The paper is being filed prior to that date.

In response to the Office Action mailed December 16, 2003, the Applicants respectfully request the Examiner to consider the following remarks.

The pending claims are shown in the **Listing of Claims**, which begins on page 2 of this paper.

The Applicants' **Remarks** begin on page 4 of the paper.

LISTING OF CLAIMS

No claims have been amended or cancelled pursuant to the present reply. Thus, claims 1-8 are pending in the present application. This Listing of Claims replaces all prior versions and listings of claims in the present application.

1. (Previously Presented) A gaming machine controlled by a processor in response to a wager, said gaming machine comprising:

a display including a video portion and a non-video portion; and

a unitary touch screen overlapping both said video portion and said non-video portion, said video portion including player-selectable first indicia selectable via said unitary touch screen and said non-video portion including permanent player-selectable second indicia selectable via said unitary touch screen.

2. (Original) The gaming machine of claim 1, wherein said video portion and said non-video portion are immediately adjacent each other.

3. (Original) The gaming machine of claim 1, wherein said non-video portion includes an artwork panel.

4. (Original) The gaming machine of claim 3, wherein said second indicia are selectively illuminated by lights located behind said artwork panel to indicate which of said second indicia are active and can be selected by a player.

5. (Original) The gaming machine of claim 3, wherein said second indicia are printed on said artwork panel.

6. (Original) The gaming machine of claim 1, wherein said second indicia are selected from a group consisting of a "Spin Reels" button, a "Bet Per Line" button, a "Max Bet Spin" button, a "Select Lines" button, a "Collect" button, a "Help" button, and a "Pay Table" button.

7. (Original) The gaming machine of claim 1, wherein said non-video portion is located below said video portion.

8. (Original) The gaming machine of claim 1, wherein said first indicia vary in at least one of location and function depending upon a segment of a game being played on the gaming machine.

REMARKS

No claims have been amended or cancelled pursuant to the present reply. Thus, claims 1-8 are pending in the present application.

Examiner Interview

The Applicants' wish to thank Examiner White for the courtesy of granting a telephone interview with the Applicants' undersigned representative on March 17, 2004. Per Examiner White's request, the Applicants are submitting this reply which repeats the Applicants' remarks as set forth in that interview. The Applicants respectfully submit that claims 1-8 are patentable over the cited references in view of these remarks.

Claim Rejections—35 U.S.C. § 103 (Heidel & Bruzzese)

Claims 1-8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,342,047 to Heidel et al. in view of EP 0 789 338 to Bruzzese. The Applicants respectfully traverse these rejections for at least the following reasons.

Claim 1, the sole independent claim in the present application, requires, *inter alia*:

a unitary touch screen overlapping both said video portion and said non-video portion, said video portion including player-selectable first indicia selectable via said unitary touch screen and said non-video portion including permanent player-selectable second indicia selectable via said unitary touch screen.

Put simply, a single touch screen covers the video and non-video portions of a display of a gaming machine. The cited references, alone or in combination, do not teach, suggest, or disclose a gaming machine having a touch screen that covers the video and non-video portions of the display.

The Applicants respectfully submit that the office action appears to mischaracterize the cited references and cites a motivation for combining the references that simply does not exist. Regarding Heidel—the primary reference—the office action states “Heidel teaches . . . the non-video portion including permanent player selectable second indicia selectable via the touch screen (abstract; Fig. 1).” Office Action, Dec. 16, 2003, at page 2. The Applicants respectfully submit that this statement mischaracterizes Heidel; Heidel only discloses that various indicia (e.g., cards 16a-16d; hold indicators 20a-e; and machine control indicators including a collect indicator 22, a bet one indicator, a bet max indicator, a deal/rebet indicator 29, and a menu indicator 24a) are displayed on the touch screen 12. Heidel at col. 2, lines 22-44 (emphasis added) and FIG. 1. Heidel does not teach, suggest, or disclose that these displayed items are

permanent as required by the Applicants' claim 1. It appears that Heidel discloses just the opposite—the various indicia are not permanent—as Heidel discloses several alternative embodiments of the display in FIGS. 1-2d, none of which include the same indicia.

The Office Action goes on to state that “. . . Heidel lacks disclosing a touch screen overlapping the non-video portion of the machine.” The Office Action then seeks to combine Heidel with Bruzzese to make up for this deficiency of Heidel:

It would have been obvious to a person of ordinary skill in the art at the time of the invention to employ the touch screen technology of Bruzzese over the non-video {electromechanical buttons} of Heidel in order to make the buttons easier to operate by making them touch sensitive. **This would allow for quicker input by the players.**

Office Action, Dec. 16, 2003, at pages 2-3 (emphasis added). The motivation cited in the Office Action for combining references and modifying Heidel to remove the electromechanical buttons—making operation easier and accelerating the game play—stands in stark contrast to the disclosure and teachings of Heidel, the primary reference. Heidel specifically states that the electromechanical game control buttons 32a-e allow for faster game play. *See, e.g.*, Heidel at col. 2, lines 53-56; *See also*, Heidel at col. 1, lines 34-44 (touch screen slows game play). Heidel further states, “. . . the experienced player can play the poker game faster by using the [electromechanical] buttons 32a-e which will tend to increase his enjoyment of the game while as the same time increase the potential earning of the machine.” Heidel at col. 3, lines 35-39. It is clear from the Heidel reference that the touch screen does not ease operation in a manner that allows for quicker input by the players as alleged in the office action. Thus, the alleged motivation for combining and modifying the cited references simply does not exist.

A *prime facie* case of obviousness requires, *inter alia*, some suggestion or motivation, in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify reference teachings or to combine reference teachings. MPEP § 2143.01. The Office Action fails to set forth a *prime facie* case of obviousness because the stated motivation for combining the cited references does not exist. Not only does the alleged motivation for combining the references not exist, the primary reference teaches away from the claimed invention—Heidel teaches that physical/electromechanical game control buttons should be used to speed game play. The law of obviousness requires that a reference be considered as a whole, including those portions that teach away from the Applicant's claimed invention. *See W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.3d 1540, 1550-51, 220 U.S.P.Q. 303, 311 (Fed. Cir. 1983)

("[T]he totality of a reference's teaching must be considered."); *see also* M.P.E.P. § 2141.02 (stating that prior art must be considered in its entirety including disclosures that teach away from the claims).

Thus, the Applicants respectfully submit that claim 1, and the claims that depend therefrom, are patentable over Heidel in view of Bruzzese under 35 U.S.C. § 103(a) for at least the foregoing reasons.

Turning now to the rejection of claim 3, which depends from claim 1, claim 3 requires that "said non-video portion includes an artwork panel," wherein the non-video portion is overlapped by a touch screen. (An example of the gaming machine having an artwork panel overlapped by a touch screen is shown in FIG. 1 and discussed at page 5, lines 5-8, of the Applicants' specification.) The combination of the cited reference does not teach, suggest, or disclose a gaming machine having an artwork panel overlapped by a touch screen. Rather, Bruzzese merely shows a plant design on the gaming machine cabinet in its FIG. 1; both references disclose a touch screen. However, there is no teaching, suggestion, or disclosure in the cited references that a touch screen overlaps an artwork panel. The mere fact that the touch screen of Heidel or Bruzzese could overlap the plane design on the Bruzzese gaming-machine cabinet does not create a *prime facie* case of obviousness because nothing in the cited references suggests the desirability of doing so. *See* M.P.E.P. § 2143.01 ("The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination"); *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

Thus, the Applicants respectfully submit that claims 3, and the claims that depend therefrom, are patentable over Heidel in view of Bruzzese under 35 U.S.C. § 103(a) for at least this reason as well.

Conclusion

In conclusion, the Applicants respectfully submit in view of the remarks set forth herein that all rejections have been overcome and that all claims are in condition for allowance, and such action is earnestly solicited.

If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the Applicants' undersigned attorney at the number indicated.

The Applicants respectfully submit that no fee is due in connection with the present Reply. The Applicants' are submitting a Petition For Extension Of Time Under 37 C.F.R. § 1.136(a) and the corresponding fee. The Commissioner is authorized to charge any required fees while this application is pending (except the issue fee) to Jenkins & Gilchrist, P.C. Deposit Account No. 10-0447(47079-00086USPT).

Respectfully submitted,

Date: March 18, 2003

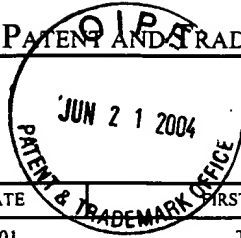


Timothy M. Kowalski
Reg. No. 44,192
JENKENS & GILCHRIST, P.C.
225 West Washington Street, Suite 2600
Chicago, IL 60606-3418
(312) 425-8518
(312) 425-3909 (fax)
tkowalski@jenkens.com

ATTORNEYS FOR APPLICANTS



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,195	03/29/2001	Timothy C. Loose	47079-00086	4522
30223	7590	04/13/2004	EXAMINER	
JENKENS & GILCHRIST, P.C. 225 WEST WASHINGTON SUITE 2600 CHICAGO, IL 60606			WHITE, CARMEN D	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/821,195

Applicant(s)

LOOSE ET AL.

Examiner

Carmen D. White

Art Unit

3714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's arguments regarding the instant claims have not been successful in overcoming the art rejection of the last office action. Applicant disagrees with the examiner's motivation for combining Heidel and Bruzzese. However, it is the examiner's assertion that the combination of Heidel and Bruzzese meet the instant claim limitations. Heidel clearly teaches the use of touch screen (on a video portion) for easy input by the players of the gaming machine. Heidel teaches a slot machine with both video (touch display) and non-video (buttons) portions. Bruzzese teaches that a touch panel can be bonded to an existing non-video portion of a machine to allow easy input by players. The invention of Bruzzese teaches the novel feature of Applicant's instant claims, which is a touch screen to cover a non-video portion of a gaming device. Touch screens are quite well known in the art. However, the use of touch screens to cover existing non-video portions of a gaming machine is less known. The examiner combined Bruzzese with Heidel in order to show that the touch screen of Bruzzese could be used to cover non-video portions of any pre-existing gaming machine with video and non-video portions. Heidel is but one example of a pre-existing gaming machine that could be used in combination with the touch screen of Bruzzese in order to meet the limitations of the instant claims. Therefore, as the claims are currently written, the examiner maintains her rejection.